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Paper No. 4

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1300 NINETEENTH STREET NW  
WASHINGTON, DC 20036

In re Application of  
Murray  
Application No. 09/677,592  
Filed: October 3, 2000  
Attorney Docket No.: 112913.210  
For: TARGETING CELLS HAVING MAD2  
MUTATION FOR TREATMENT AND/OR  
PREVENTION OF DISEASE

OFFICE OF PETITIONS  
A/C PATENTS  
ON PETITION

This is a decision on the petition, filed April 16, 2001, under 37 C.F.R. § 1.182, and, alternatively, under 37 C.F.R. § 1.183, to reconsider a previous Office decision and enter the concurrently filed petition for a filing date in twelve pending patent applications.

This is also a decision on the petition filed concurrently, under 37 C.F.R. § 1.182 and, alternatively, under 37 C.F.R. § 1.183, to accord the above-identified application a filing date of October 2, 2000 instead of the currently accorded filing date of October 3, 2000.

**FACTS**

Petitioner has provided a long and arduous recitation of the facts surrounding the filing of the above-identified application. A brief synopsis is herein provided.

1. Applicant prepared a multitude of patent applications for filing on October 2, 2000, including the above-referenced application;

2. On October 2, 2000, the employee charged with delivering the twelve applications to the USPTO mail room before midnight became ill with the medical condition of Fibromyalgia Syndrome;

3. Applicant was informed by the employee charged with delivering the applications that said employee did not arrive at the USPO mail room prior to midnight on October 2, 2000 at which point applicant, desirous of an October 2, 2000 filing date and aware of the time difference in Hawaii, procured the services of a patent attorney in Hawaii, and, thereafter, via E-mail and facsimile, arranged to have the Hawaiian practitioner assemble the applications on applicant's behalf and deposit them into Express Mail service;

5. The Hawaiian practitioner arrived at the post office before midnight, Hawaiian time, only to discover that the post office had closed at 8:30pm and moreover the Express Mail service window had closed at 8:00pm;

6. Either prior to midnight Hawaiian time or shortly thereafter, the Hawaiian practitioner deposited the twelve applications into an Express Mail 'drop box'.

### **DISCUSSION**

Petitioner requests reconsideration of a previous Office decision dismissing petitioner's request that the concurrently filed petition for a filing date be entered into the record of twelve pending patent applications. Petitioner requests this relief under the provisions of 37 C.F.R. 1.182<sup>1</sup>.

Petitioner was previously advised by the Office to submit separate petitions for each application for which petitioner desires consideration in a decision mailed March 21, 2001 in application No. PCT/US00/27462. This decision dismissed petitioner's request that the petition for a filing date be entered into the record of twelve pending patent applications.

As stated in the previous decision, 37 C.F.R. § 1.4(b) requires that a separate copy of every paper filed in a patent or trademark application, patent file, trademark registration file, or other proceeding must be furnished for each file to which the paper pertains, even though the contents of the papers filed in two or more files may be identical.

Relief under 37 C.F.R. § 1.182 is only available for situations not specifically provided for under Title 37 of the Code of Federal Regulations. Therefore, the request for relief under 37 C.F.R. § 1.182 with regard to this matter is inappropriate given 37 C.F.R. § 1.4(b) specifically provides for the filing of separate papers for each application to which the papers pertain.

The request that the concurrently file petition be entered into the record of twelve pending patent applications under the provisions of 37 C.F.R. § 1.182 is **DISMISSED**.

Petitioner requests, alternatively, reconsideration of the previous Office decision in application No. PCT/US00/27462 dismissing petitioner's request that the concurrently filed petition for a filing date be entered into the record of twelve pending patent applications under the provisions of 37 C.F.R. § 1.183<sup>2</sup>.

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<sup>1</sup>37 C.F.R. § 1.182 provides that [a]ll situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

<sup>2</sup>37 C.F.R. § 1.183 provides that [i]n an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in §

Petitioner argues that the requirements of 37 C.F.R. § 1.4(b) do not apply to the twelve applications related to this matter because at the time the initial petition was filed in application No. PCT/US00/27462, application numbers had not yet been issued in all of the remaining eleven applications involved in this matter and therefore 37 C.F.R. § 1.4(b) should be waived or suspended under the provisions of 37 C.F.R. § 1.183.

Petitioner's argument is not convincing. The suspension or waiver of the rules is provided for extraordinary circumstances. While petitioner's desire to promptly address the matter of the filing date is acknowledged, it is not found to be an extraordinary circumstance such that suspension or waiver of the requirement that a separate copy of every paper be furnished for each file to which the paper pertains is warranted. As each application file must be a complete record in and of itself, the requirement for the separate submission of papers cannot be taken lightly.

Moreover, as of the filing of the instant petition on April 16, 2001, each application to which petitioner would have this single currently filed petition apply had been assigned a serial number. Therefore to the extent that petitioner's need to submit a single petition in numerous applications warranted merit as an "extraordinary circumstance," the existence of said extraordinary circumstance no longer existed as of the filing of the instant petition to waive the requirements of 37 C.F.R. § 1.4(b).

Petitioner is also reminded that submission of correspondence without an identifiable application number is strongly discouraged under 37 C.F.R. § 1.5(a) wherein it states in relevant part that "[n]o correspondence relating to an application should be filed prior to receipt of the application number from the Patent and Trademark Office."

The petition under 37 C.F.R. § 1.183 for a waiver or suspension of the requirements of 37 C.F.R. § 1.4(b) is **DISMISSED**.

Petitioner additionally requests under the provisions of 37 C.F.R. § 1.182 that the above-identified application be accorded a filing date of October 2, 2000 instead of the currently accorded filing date of October 3, 2000.

The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Commissioner. See, 35 U.S.C. 21(a).

The authority granted to the Commissioner under 35 U.S.C. 21(a) has been exercised at 37 C.F.R. § 1.6, whereby receipt in the Patent and Trademark Office of correspondence establishes the filing date of the correspondence, and at 37 C.F.R. § 1.10, whereby date of deposit of the correspondence into Express Mail service establishes the filing date of the correspondence.

The above-identified application was filed under the provisions of 37 C.F.R. § 1.53(b). The filing date of an application for patent filed under the provisions of 37 C.F.R. § 1.53(b) is the date on which application papers (specification, claims, and drawings) meeting the requirements of 35 U.S.C. § 112 are filed in the Patent and Trademark Office. See, 37 C.F.R. § 1.53(b).

As previously stated, relief under 37 C.F.R. § 1.182 is only available for situations not specifically provided for under Title 37 of the Code of Federal Regulations. Therefore, the request for relief under 37 C.F.R. § 1.182 with regard to this matter is inappropriate given the accordance of a filing date for correspondence filed with the Office is specifically addressed at 37 C.F.R. §§ 1.6 and 1.10.

The petition to accord the above-identified application a filing date of October 2, 2000 instead of the presently accorded filing date of October 3, 2000 under 37 C.F.R. § 1.182 is **DISMISSED**.

Lastly, petitioner alternatively requests the requirements set forth under 37 C.F.R. §§ 1.6(c) and 1.10 be suspended or waived under the provisions of 37 C.F.R. § 1.183 and that the above-identified application be accorded a filing date of October 2, 2000 instead of the currently accorded filing date of October 3, 2000. Petitioner states that failure to accord the above-identified application a filing date of October 2, 2000 will result in the loss of substantive rights.

Petitioner indicates that on October 2, 2000, efforts were made to file twelve applications, including the above-identified application, under the provisions of 37 C.F.R. § 1.6(c)<sup>3</sup>. Petitioner further indicates that failure to deliver the applications to the USPTO prior to midnight on October 2, 2000 resulted directly from the medical condition suffered by the employee charged with making the delivery.

While it is noted that petitioner indicates the employee's failure to deliver the above-referenced application prior to midnight on October 2, 2000 was the result of a medical condition, the employee's medical condition can hardly be deemed the sole basis for failure to file the application prior to midnight on October 2, 2000. The totality of circumstances leading up to the employee's efforts to deliver the application to the USPTO prior to midnight on October 2, 2000 must be examined. The Verified Statement of Corinne M. Pouliquen submitted herewith indicates that "[t]he twelve applications ... were being put in final form throughout the day and into the evening of Monday, October 2, 2000." It is obvious that applicant elected to wait until the last possible moment to prepare and attempt to file twelve applications for patent. In so doing, applicant undertook the risk that the above-referenced application would not be filed prior to midnight on the evening of October 2, 2000.

Applicant additionally attempted to file the above-referenced

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<sup>3</sup>37 C.F.R. § 1.6(c) *Correspondence delivered by hand*. In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

application pursuant to the provisions of 37 C.F.R. § 1.10(a)<sup>4</sup> when unable to file the applications prior to midnight E.S.T. October 2, 2000 under the provisions of 37 C.F.R. § 1.6(c). Applicant engaged the services of a Hawaiian practitioner in an attempt to deposit the above-referenced application into Express Mail prior to midnight October 2, 2000 Hawaiian time. The time at which the person charged with depositing the above-referenced application into Express Mail service is irrelevant given the "Verified Statement" of Jack E. Bennett accompanying the instant petition acknowledges that the above-referenced application was deposited into Express Mail service after the last scheduled pickup for that day as per the requirements of 37 C.F.R. § 1.10(d)(3)<sup>5</sup>.

Despite all of applicant's extreme last minute efforts to prepare the above-referenced application for filing on October 2, 2000, the above-referenced application did not arrive at the USPTO prior to midnight on the evening of October 2, 2000 nor was the application deposited into Express Mail service prior to the last scheduled pickup for October 2, 2000. While applicant undertook extreme efforts to attain an October 2, 2000 filing date, these efforts are not deemed extraordinary within the meaning of 37 C.F.R. § 1.183. Indeed, failure to deliver the above-referenced application to the USPTO prior to midnight on October 2, 2000 as per 37 C.F.R. § 1.6(c) and failure to deposit the application into Express Mail service prior to the last scheduled pickup as per 37 C.F.R. § 1.10(d)(3) was but an expected occurrence given the obvious lack of diligence undertaken in preparing the application from the onset.

While it is acknowledged that applicant may incur a loss of

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<sup>4</sup>37 C.F.R. § 1.10(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date.

<sup>5</sup>37 C.F.R. § 1.10 Filing of papers and fees by "Express Mail."

(d) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

...

(3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Address" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Address" service of the USPS.

substantive rights if not granted a filing date of October 2, 2000, such a loss is not deemed "extraordinary" within the meaning of 37 C.F.R. § 1.183. See, Nitto Chemical Industry. Co., Ltd. v. Comer, 39 U.S.P.Q2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 C.F.R. § 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183).

Petitioner alleges that the Office has the statutory authority under 35 U.S.C. 21(a) to accord the above-referenced application a filing date of October 2, 2000. Petitioner is of the belief that 35 U.S.C. 21(a) would allow the Office to grant the above-referenced application a filing date of October 2, 2000 simply because the above-referenced application was physically within a United States postal facility prior to midnight Hawaiian time on October 2, 2000 and may or may not have been deposited into an Express Mail drop-box prior to midnight Hawaiian time on October 2, 2000.

Petitioner is mistaken in this interpretation of 35 U.S.C. 21(a).

Title 35 of the United States Code Sec. 21(a) states as follows:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

The rulemaking authority granted to the Director at 35 U.S.C. 21(a) has been exercised at 37 C.F.R. §§ 1.6 and 1.10. While 37 C.F.R. § 1.183 empowers the Commissioner to suspend or waive the provisions of 37 C.F.R. §§ 1.6 and 1.10 in an extraordinary situation, petitioner has presented no evidence of an extraordinary situation, and, more importantly, the Commissioner has no statutory authority to consider an application deposited into USPS Express Mail service on October 3, 2000 as one deposited with the USPS on October 2, 2000.

Accordingly, the petition to accord the above-identified application a filing date of October 2, 2000 instead of the currently accorded filing date of October 3, 2000 under 37 C.F.R. § 1.183 is **DISMISSED**.

#### **CONCLUSION**

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTH** from mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are not permitted.

Please be advised that the address listed on the instant petition is different than the correspondence address of record. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all

future correspondence will be mailed solely to the address of record.

Petitioner is also advised that a proper response to the "Notice to File Missing Parts of Nonprovisional Application" mailed December 11, 2000 to the correspondence address of record was due on or before February 11, 2001.

Any further correspondence with respect to this matter should be addressed as follows:


By mail: Commissioner for Patents  
Box DAC  
Washington, DC 20231

By FAX: (703) 308-6916  
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23  
2201 S. Clark Place  
Arlington, VA

This application is being forwarded to the Office of Initial Patent Examination to await applicant's response to the Notice mailed December 11, 2000 and for further processing with a filing date of October 3, 2000.

Telephone inquiries related to this decision may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

  
Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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